

Application No.: 10/827,324
Amendment and Response dated July 10, 2006
Reply to Office Action of April 10, 2006
Docket No.: LC-487 US (500-188)
Page 12

REMARKS

Claims 1-25 are currently pending in this application. Claims 1-9 and 11-22 have been withdrawn from active prosecution as a result of a restriction requirement. Claims 10 and 23-25, each of which being in independent form and having been amended herein. Support for these amendments is replete throughout the application and as such no new matter has been introduced thereby. Applicants respectfully request reconsideration in view of the above amendments and the following remarks.

Applicants' Response to Restriction Requirement

In the Office Action, the Examiner has required restriction under 35 U.S.C. §121 between one of the following Groups, which the Examiner has identified as distinct inventions:

Group I: Claims 1-11 and 23-25, drawn to a composition, classified in class 528, subclass 322.

Group II: Claims 12-22, drawn to a method of bonding substrates and coated substrates, classified in class 156, subclass 331.1.

Applicants affirm their provisional election with traverse to prosecute the claims placed in Group I. With respect to the species election requirement, Applicants confirm the election of the compositions including maleimides. Claims 10 and 23-25 read on this species.

Applicants' Response to 35 U.S.C. §112, Second Paragraph Rejection

Claim 10 is rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. In particular, the Examiner asserts that "J" is left undefined. Applicants' have amended claim 10 herein to clarify the definition of "J". Therefore, Applicants respectfully submit that the Section 112 rejection has been overcome.

Application No.: 10/827,324
Amendment and Response dated July 10, 2006
Reply to Office Action of April 10, 2006
Docket No.: LC-487 US (500-188)
Page 13

Applicants' Response to 35 U.S.C. §102 or §103 Rejection over Ikeguchi

Claims 10 and 23-25 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by, or in the alternative under 35 U.S.C. §103(a) as allegedly being obvious over, U.S. Patent No. 4,373,086 to Ikeguchi (hereinafter “Ikeguchi”). Applicants respectfully request reconsideration on the basis that Ikeguchi fails to disclose, teach or suggest Applicants’ claims as amended herein.

The Examiner contends that “Ikeguchi suggests curable compositions of polyfunctional cyanate esters, a polyfunctional acrylate and a polyfunctional maleimide.” (Office Action, at Page 4) (citations omitted). The Examiner further asserts that the compositions of Ikeguchi “can be cured by heat alone or nonmetallic catalysts.” (Office Action, at Page 4) (citations omitted).

Applicants have amended claims 10 and 23-25 herein to further define the claimed invention. In particular, the amended claims include an anaerobic cure-inducing composition and additionally require that the claimed composition “cures at room temperature when placed between two surfaces at least one of which is an active metallic surface.” The anaerobic cure-inducing compositions of the present application include, for example, initiators, accelerators and/or stabilizers, as shown in Examples 1, 3 and 15 and further disclosed on pages 21-22 of the specification.

Ikeguchi fails to teach or suggest the inclusion of an anaerobic cure-inducing composition, as well as compositions that cure at room temperature when placed between surfaces at least one of which is metallic. In contrast, and as acknowledged by the Examiner in the passage quoted above, the compositions of Ikeguchi require at least heat for curing. Ikeguchi discloses that catalysts may be used in addition to heat for curing. All of the examples of Ikeguchi employ heat and a metal catalyst for cure. Example 1 uses heat (at temperatures of 160°C and 175°C) and a zinc octoate catalyst to cure the composition. (Col. 8; lines 57-67.) Example 2 uses the same process for curing as Example 1. (Col. 9; lines 14-15.) Example 3 similarly uses heat (at temperatures of 170°C and 195°C) and a zinc octoate catalyst to cure.

Application No.: 10/827,324
Amendment and Response dated July 10, 2006
Reply to Office Action of April 10, 2006
Docket No.: LC-487 US (500-188)
Page 14

(Col. 9; lines 36-55.) Nowhere in Ikeguchi are room temperature curing compositions, which cure anaerobically when placed between two surfaces at least one of which is metallic, disclosed or suggested.

It is well settled that to be an effective anticipatory reference, a cited document must disclose each and every limitation recited in a claim under examination. Failing such precise disclosure, such a cited document must fail as an anticipatory reference. Therefore, Ikeguchi cannot anticipate Applicants' amended claims.

Moreover, there is no suggestion in Ikeguchi that its compositions cure anaerobically at room temperature when placed between two surfaces at least one of which is metallic. Ikeguchi specifically states that its compositions require at least heat for cure. Elimination of the heat curing requirement would result in an improper modification of Ikeguchi. *See* MPEP §2143.01 (“If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”). Any such modification of Ikeguchi must have come from the use of hindsight reasoning, using Applicants claims as a template from which to pick and choose which portions of Ikeguchi seemingly are relevant but require modification. As such, Ikeguchi also fails to suggest Applicants' amended claims.

In view thereof, amended claims 10 and 23-25 are patentable over Ikeguchi. Applicants respectfully request reconsideration of the Section 102 and Section 103 rejections based on this reference.

Applicants' Response to 35 U.S.C. §102 or §103 Rejection over Gaku

Claims 10 and 23-25 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by, or in the alternative under 35 U.S.C. §103(a) as allegedly being obvious over, U.S. Patent No. 4,369,304 to Gaku (hereinafter “Gaku”). Applicants respectfully request reconsideration on the basis that Gaku fails to disclose, teach or suggest Applicants' claims as amended herein.

The Examiner contends that “Gaku suggests curable compositions of polyfunctional cyanate esters, an acrylate and a polyfunctional maleimide.” (Office Action, at Page 5) (citations omitted). The Examiner further asserts that the compositions of Gaku “can be cured by heat alone or nonmetallic catalysts.” (Office Action, at Page 5) (citations omitted).

As discussed above, Applicants’ invention is based on anaerobic cure and Applicants accordingly have amended claims 10 and 23-25 herein to include an anaerobic cure-inducing composition and additionally require that the claimed composition “cures at room temperature when placed between two surfaces at least one of which is an active metallic surface.”

In contrast, and as acknowledged by the Examiner in the passage quoted above, Gaku requires heating of the composition to effect curing. Gaku discloses that catalysts may be used in addition to heat for curing. Similar to the disclosure of Ikeguchi, all of the examples of Gaku employ heat and a metal catalyst for cure. Example 1 uses heat (at temperatures of 150°C) and a zinc octoate catalyst to cure the composition. (Col. 6; lines 12-22.) Example 2 also uses heat (at temperatures of 60°C and 140°C) and a zinc octoate catalyst to cure the composition. (Col. 6; lines 56-62.) Example 3 similarly uses heat and a zinc octoate catalyst to cure. (Col. 7; lines 5-10.) Nowhere in Gaku are room temperature curing compositions, which cure anaerobically when placed between two surfaces at least one of which is metallic, disclosed, taught or suggested. Moreover, nowhere in Gaku is the inclusion of an anaerobic cure-inducing composition disclosed, taught or suggested.

As noted above, a cited document must disclose each and every limitation recited in a claim under examination to be an effective anticipatory reference. Failing such precise disclosure, such a cited document must fail as an anticipatory reference. Therefore, Gaku cannot anticipate Applicants’ amended claims.

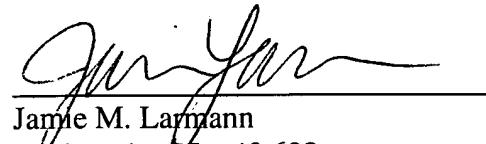
Application No.: 10/827,324
Amendment and Response dated July 10, 2006
Reply to Office Action of April 10, 2006
Docket No.: LC-487 US (500-188)
Page 16

Moreover, there is no suggestion in Gaku that its compositions cure anaerobically at room temperature when placed between two surfaces at least one of which is metallic. Gaku specifically states that its compositions require at least heat for cure. Elimination of the heat curing requirement would result in an improper modification of Gaku and destroy it for what it fairly teaches. *See MPEP §2143.01* ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."). Any such modification of Gaku must have come from the use of hindsight reasoning, using Applicants claims as a template from which to pick and choose which portions of Gaku seemingly are relevant but require modification. As such, Gaku also fails to suggest Applicants' amended claims.

In view of the above, amended claims 10 and 23-25 are patentable over Gaku. Applicants respectfully request reconsideration of the Section 102 and Section 103 rejections based on this document.

Applicants' undersigned attorney may be reached by telephone at the number given below.

Respectfully submitted,



Jamie M. Lamann
Registration No. 48,623
Attorney for Applicants

HOFFMANN & BARON, LLP
6900 Jericho Turnpike
Syosset, New York 11791
(973) 331-1700